

Docket No. 115243.00005

Serial No. 10/781,079

REMARKS

Claims 1 through 19 are in the case. Claims 1, 6, 7, 11, 16 and 17 are amended by this amendment.

Claims 1, 4, 5, 8, 11, 14, 15, 18 and 19 rejected under 35 U.S.C. § 102(b) as being anticipated by O'Hara, US 3,619,072.

The Examiner stated that O'Hara discloses the claim invention, a method of evaluating engine operation comprising receiving a oil sample from an engine and determining a profile of particulates in the oil, the profile having predetermined characteristics providing an indication of the operating condition of the engine and indicating whether the particulates are engine-based or oil-base. The profile of wear and breakdown products (degradation) products is used as an "early warning system" to assess reliability, predict failure and operating condition of the electrical equipment.

The Examiner further stated that engines are considered to be "electrical equipment" as claimed, since the claims are given their broadest possible interpretation during examination, and engines utilize electrical energy during operation.

Applicant respectfully disagrees that independent claims 1 and 11 are anticipated by O'Hara. MPEP §2111 states that the pending claims must be given their broadest *reasonable* interpretation *consistent* with the specification (emphasis added). In re Hyatt, 211 F.3d 1267, 54 USPQ2d 1664 (Fed Cir. 2000), In re Jujiro Yamamoto, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984). Further, the Federal Circuit Court of Appeals has stated that although the PTO must give claims their broadest reasonable interpretation, this interpretation *must be consistent with the one that those skilled in the art would reach* (emphasis added). In re Cortright, 165 F.3d 1353, 49 USPQ2d 1464 (Fed. Cir. 1999). Applicant submits that based upon the invention described in the specification and as claimed, that one skilled in the art would *not* interpret O'Hara as disclosing electrical equipment as used in the claims by Applicant. Applicant agrees that the engines of O'Hara include electrical equipment. However, the electrical equipment of O'Hara, such as alternators, do not include liquids that can be analyzed for wear products and breakdown products. Applicant submits that under the broadest reasonable interpretation consistent with the specification, as required by the Federal Circuit Court of Appeals, claim 1 is not anticipated by O'Hara.

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With respect to claim 19, Applicant submits that even under the broadest possible interpretation, claim 19 is not anticipated by O'Hara because nothing in O'Hara discloses or suggests analyzing *insulating* liquid because 1) the engines disclosed in O'Hara do not use *insulating* liquid and 2) any electrical equipment included in O'Hara does not contain liquids.

Claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Hara in view of Butler.


Applicant disagrees that claims 9 and 10 are obvious in view of O'Hara and Butler. Butler discloses a transformer leak alarm for detecting leaks in oil circuitry external to the transformer. Butler does not disclose or suggest anything that relates to analyzing fluid contained within the transformer. The Examiner has not stated any motivation for one skilled in the art to combine the teachings of O'Hara and Butler. Applicant submits that since Butler is a system for monitoring for external leakage, one skilled in the art would not be motivated to combine the teachings of O'Hara and Butler as suggested by the Examiner.

Claims 6, 7, 16 and 17 were rejected under the judicially created doctrine of obviousness-type double patenting as being over claim 7 of U.S. Patent No. 6,691,557 in view of O'Hara.

Claims 6, 7, 16 and 17 have been re-written in independent form including the limitations of the independent claim, and any intervening claims, from which each claim depended. Enclosed is a terminal disclaimer with regard to U.S. Patent No. 6,691,557, which should obviate this rejection.

In view of the above, it is respectfully submitted that claims 1 through 19 are in condition for allowance. Reconsideration of the rejections is requested and allowance of the claims is solicited.

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